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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/672,692	09/26/2003	Satoshi Hiratsuka	YAMA-0059	9284
37013 7590 08/12/2011 Rossi, Kimms & McDowell LLP 20609 Gordon Park Square Suite 150 Ashburn, VA 20147				
			EXAMINER WILLIAMS, JEFFERY L.	
			ART UNIT 2437	PAPER NUMBER
			NOTIFICATION DATE 08/12/2011	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mail@rkmllp.com

Office Action Summary

Application No.

10/672,692

Applicant(s)

HIRATSUKA, SATOSHI

Examiner

JEFFERY WILLIAMS

Art Unit

2437

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 July 2011.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 4 - 6, 8, 9, and 11 - 16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 4 - 6, 8, 9, and 11 - 16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-945)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

This action is in response to the communication filed on 7/9/11.
All objections and rejections not set forth below have been withdrawn.
Claims 1, 4 – 6, 8, 9, and 11 – 16 are pending.

Response to Amendment

The reply filed on 7/19/2011 is not fully responsive because it fails to include a record of the substance of the 4/1/2011 interview. Since the above mentioned reply appears to be *bona fide*, applicant is given a TIME PERIOD of **ONE (1) MONTH or THIRTY (30) DAYS** from the mailing date of this notice, whichever is longer, within which to supply the omission or correction in order to avoid abandonment.
EXTENSIONS OF THIS TIME LIMIT MAY BE GRANTED UNDER 37 CFR 1.136(a).

Priority

Applicant cannot rely upon the foreign priority papers to overcome this rejection because a translation of said papers has not been made of record in accordance with 37 CFR 1.55. See MPEP § 201.15.

Specification

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required:

The specification fails to provide proper antecedent basis for the recitations of a "terminal controller that sends to the contents supplying server apparatus a permission request..." (claim 1; essentially similar recitations found within claims 9, 15).

Regarding the applicant's newly added recitation of a "terminal controller", the examiner respectfully notes that applicant's originally filed specification disclosed two separate and distinct terminal elements of a "sending section" and a "terminal controlling section". Analysis of applicant's originally filed specification would suggest that the originally recited "sending section" would correspond to applicant's disclosure of the terminal's communication interface, which is a system element adapted to send (e.g. see figure 1B:8). Furthermore, the originally recited "terminal controlling section" would clearly appear to correspond to the originally disclosed CPU within the terminal (e.g. see figure 1B:1).

However, at present, it appears the applicant is replacing each of the distinct recitations of a "sending section" and "terminal controlling section" with the single recitation of "terminal controller". Further, Applicant argues that the newly recited

"terminal controller" is "a *specialized controller, which is structural, that is physically different from a controller that does not*" (see Remarks, pg. 9). Applicant does not state for the record as to whether the applicant regards the newly added recitation of "terminal controller" to be equivalent and correspond to the originally disclosed CPU (1) (i.e. "terminal controlling section").

Further, it is noted that applicant's originally filed specification discloses that it is the "sending section" that sends permission requests (e.g. see original claim 1). There appears to be no antecedent support within the applicant's original disclosure for the amended recitation of "terminal controller that sends to the contents supplying server apparatus a permission request...".

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1, 4 – 6, 8, 9, and 11 – 16 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Applicant has not pointed out where the new (or amended) claim is supported, nor does there appear

to be a written description of the claim limitations in the application as filed (see above objection to the specification).

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 4 – 6, 8, 9, and 11 – 16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Specifically, regarding claims 1, 6, 9, and 16, they are rejected as ambiguous as they comprise new and unexplained recitations of a “terminal controller”. The examiner respectfully notes that applicant’s originally filed specification disclosed two separate and distinct elements of a terminal, comprising a “sending section” and a “terminal controlling section”. Analysis of applicant’s originally filed specification would suggest that the originally recited “sending section” would correspond to applicant’s disclosure of the terminal’s communication interface, which is a system element adapted to send (e.g. see figure 1B:8). Furthermore, the originally recited “terminal controlling section” would clearly appear to correspond to the originally disclosed CPU within the terminal (e.g. see figure 1B:1). However, at present, it appears the applicant is replacing each of the distinct recitations of a “sending section” and “terminal controlling section” with the single recitation of “terminal controller”. Further, Applicant argues that the newly recited “terminal controller” is *“a specialized controller, which is structural, that is physically different from a controller that does not”* (see Remarks, pg. 9). Applicant

does not state for the record as to whether the applicant regards the newly added recitation of "terminal controller" to be equivalent and correspond to the originally disclosed CPU (1) (i.e. "terminal controlling section") or to the originally disclosed "sending section" (i.e. communications interface 8).

For the purpose of examination, including the application of prior art, the examiner interprets the claimed "terminal controller" to correspond to the originally disclosed CPU within the terminal (e.g. Fig. 1B:1).

Depending claims are rejected by virtue of dependency.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 4 – 6, 8, 9, and 11 – 16 are rejected under 35 U.S.C. 102(b) as being anticipated by Nozaki et al., (Nozaki), US Patent Publication 2002/0036800 A1.

Regarding claim 1, Nozaki discloses:

1 *A contents supplying server apparatus that supplies contents for downloading via*
2 *a communication network (fig. 2:1; see also figs. 12 -14, par. 220-221);*

3 *and a plurality of information processing terminals associated with a user,*
4 *contents from the contents supplying server apparatus being downloadable to each*
5 *information processing terminal from the contents supplying server apparatus via a*
6 *communication network (fig. 2:2a, 2b, 3, 5, 6; par. 13,14, 40, 48 – herein the Nozaki*
7 *discloses the prior art feature of a user possessing a plurality of "information processing*
8 *terminals", wherein the "information processing terminals" [e.g. fig. 2: 2a, 2b] are each*
9 *connected to "a communication network" and may be used to download "contents" from*
10 *a "contents supplying server apparatus"),*

11 *wherein the contents supplying server apparatus comprises: a server storing*
12 *device storing, together with numerous contents, user information for the user,*
13 *including user ID information representing a plurality of information processing terminals*
14 *associated with the user and contents purchase information comprising contents ID*
15 *information and copy control data, wherein the copy control data includes a total*
16 *number of times the downloaded contents are allowed to be copied to an external*
17 *apparatus or recording medium (fig. 3:8, see also fig. 13,14, par. 220,221 - herein*
18 *Nozaki discloses a server storing device for storing content, user id information, and*
19 *content purchase information; par. 113, 190, 212-215, see also, par. 63,73,80 – herein*
20 *Nozaki discloses that the server apparatus is provided with copy control data indicating*
21 *the maximum allowed copies as dictated by a copyright holder);*

1 *and a server controller that in response to a copy permission request from the*
2 *user via one of the information processing terminals: supplies the copy control data of*
3 *the user to the one information processing terminal (par. 62, 63, 105-107, 113, 146, 147*
4 *– it is herein noted that Nozaki discloses that one of the information processing*
5 *terminals receives the copy control data), and decrements the total number of times the*
6 *downloaded contents are allowed to be copied from any of the information processing*
7 *terminals associated with the user (par. 62, 63, 105-107, 113, 207, 212 – 213 – herein*
8 *Nozaki discloses that the server's copy control data is amended until it reaches zero, at*
9 *which point the server must re-order),*

10 *wherein each of the information processing terminals comprises: a terminal*
11 *storing device that stores the downloaded contents from the contents supplying server*
12 *apparatus (fig. 4:21);*

13 *and a terminal controller that sends to the contents supplying server apparatus a*
14 *copy permission request (par. 77; fig. 4:36, 28) for copying the downloaded contents to*
15 *the external apparatus or recording medium each time before the downloaded contents*
16 *are to be copied to the external apparatus or recording medium (par. 100, 113, 141; fig.*
17 *1). Herein, the examiner notes that the prior art anticipates the recited structure of a*
18 *"sending section" of the claimed apparatus. However, for the applicant's benefit, the*
19 *examiner notes that Nozaki anticipates such intended use recitation. Regarding the*
20 *applicant's description of an intended use for the "sending section", the examiner notes*
21 *that Nozaki discloses a "sending section" that can be used to make a "copy permission"*
22 *request each time a copy is to be made. Note, that Nozaki allows copyright holders or*

distribution servers to limit the copy count at their discretion, such that a user would be required to request a reuse information key before making a copy (par. 100, 113, 141; fig. 1; see also par. 146).

Regarding claim 4, Nozaki discloses:

wherein said server storing device stores an initial value of the copy control data, contents by contents (par. 63).

Regarding claim 5, Nozaki discloses:

wherein said contents are music data (par. 28).

Regarding claims 6, 8, 9, 13, 15, and 16 they are program, method, and apparatus claims corresponding to claims 1, 4, and 5, and they are rejected, at least, for the same reasons. Furthermore regarding claims 6 and 15, Nozaki discloses:

a receiving section for receiving the copy control data of the downloaded contents to be copied to the external apparatus or recording medium from the contents supplying server apparatus (par. 78; fig. 4:30, 28);

the terminal controller also determines whether or not to copy the downloaded contents to the external apparatus or recording medium based on the received copy control data (fig. 4:35; par. 76).

Regarding claims 12 and 13, they recite wherein the external apparatus is an electronic musical instrument, however, the examiner notes that "the external apparatus" is not a required limitation of the claims. Therefore, though Nozaki discloses an apparatus capable of reproducing musical notes or sounds (par. 44), it is not necessary to address this recitation.

The examiner respectfully suggests that the applicant explicitly limit the apparatus of claim 1 and the system of claim 6 as comprising the recited electronic musical instrument.

Regarding claim 14, the examiner notes that Nozaki discloses an apparatus capable of reproducing musical notes or sounds (par. 44).

Response to Arguments

Applicant's arguments filed 7/19/11 have been fully considered but they are not persuasive.

Applicant argues essentially that:

First, as to the claimed feature (1)(B)(ii) outlined above, the examiner continues to assert that Nozaki discloses a server that keeps track of copy count and changes the stored value representing the copy count unit it reaches zero, relying on paragraphs 62, 63, 105-107, 113, 146, 147, 207, 212, and 213.

1 In contrast to the examiner's assertion, applicant submits that Nozaki discloses
2 the PC (e.g., the information processing terminal), and not the server, decrementing the
3 count. ...

4

5 ... Nozaki does not disclose anywhere that the **server** changes the count
6 information or keeps track of copy count information or that the PC sends the count
7 information to the server each time it copies the already downloaded music contents.
8 Indeed, while the server initially sets the maximum number of copies the music contents
9 can be copied, it does not keep track of the copy count. That is, in Nozaki, the PC side
10 keeps track of number of times the already downloaded contents have been copied.

11 ...

12 (Remarks, pg. 7, 8

13 *The examiner respectfully responds:*

14 The examiner respectfully disagrees. The prior art clearly shows that the server
15 comprises means to manage, including decrementing, the copy count and employs
16 such means to decrement the copy count (e.g. Nozaki, fig. 3:22; par. 26, 212-213).

17
18 *Applicant argues essentially that:*

19 ... Specifically, the examiner asserts that Nozaki's sending section can send a
20 copy permission request each time a copy is to be made. In this respect, the examiner
21 somehow urges that allowing copyright holders or distributing servers limiting copy

count at their discretion would require a reuse information key request before making a copy, relying on paragraphs 100, 113, 141, 146.

Applicant submits that the paragraphs relied upon by the examiner do not disclose or teach, or provide any basis for, having the user PC send a copy permission request each time a copy is made. There simply is no teaching anywhere for having the PC send a copy permission request each time a copy is made. Note that the reuse request is made by the PC only after it determines that the copy count remaining is zero.

(Remarks, pg. 9)

The examiner respectfully responds:

The examiner respectfully disagrees. The prior art clearly supports the prerogative of the content provider to limit the copy permissions to an individual copy, thus inciting the PC to request permission each time it requires a new copy (par. 100, 113, 141; fig. 1; see also par. 146).

Applicant argues essentially that:

None of the passages relied upon by the examiner disclose any mention of any ID information representing a plurality of information processing terminals associated with the user.

(Remarks, pg. 10)

The examiner respectfully responds:

In response, the examiner respectfully disagrees. The examiner points out that the claims recite storing only **user ID information** not data comprising a description of each of the plurality of terminals. Regardless of whether or not the applicant intends for the stored user ID information to symbolize or represent a plurality of terminals, such a characterization does represent the storing a data description of each of the plurality of terminals, as the applicant appears to suggest is a missing feature within the prior art.

The prior art clearly discloses the claimed subject matter of storing *user id information* (par. 113, 190, 212-215).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

See Notice of References Cited.

A shortened statutory period for reply is set to expire **3** months (not less than 90 days) from the mailing date of this communication.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JEFFERY WILLIAMS whose telephone number is (571)272-7965. The examiner can normally be reached on 8:30-5:00.

Art Unit: 2437

1 If attempts to reach the examiner by telephone are unsuccessful, the examiner's
2 supervisor, Eleni Shiferaw can be reached on (571)272-3867. The fax phone number
3 for the organization where this application or proceeding is assigned is 571-273-8300.

4 Information regarding the status of an application may be obtained from the
5 Patent Application Information Retrieval (PAIR) system. Status information for
6 published applications may be obtained from either Private PAIR or Public PAIR.
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11 USPTO Customer Service Representative or access to the automated information
12 system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

13
14
15 /Jeffery Williams/
16 Examiner, Art Unit 2437
17 /Eleni A Shiferaw/
18 Supervisory Patent Examiner, Art Unit 2437